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3/13/08

In re Application of:
Chobotov, Michael V. et al.
Serial No. 10/686,863
Filed: Oct. 16, 2003
Docket: 021630-000522US

DECISION ON PETITION
UNDER 37 CFR § 1.181

Title: DELIVERY SYSTEM AND METHOD
FOR BIFURCATED GRA

This is a decision on the petition filed Oct. 3, 2007 petitioning the Technology Center Director under 37 CFR § 1.181 for supervisory review and withdrawal of the requirement under 37 CFR § 1.105. No fee is due.

The petition is dismissed.

Background

The Examiner assigned to the application mailed a 37 CFR § 1.105 requirement to Applicants on May 3, 2007 requiring Applicants to disclose all co-pending applications and related patents to the application being examined and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims. Examiner cited ten applications and seventeen patents that Examiner is presently aware of and believes may be related and have overlapping subject matter. Examiner makes the requirement on the basis that Applicants or the assignee are presumably far more cognizant of the contents of the claims in these applications than any Office staff, and has access to the source documents by which comparisons could be done better than within the Office for the Examiner to thereby determine the commonality among the claims by this information.

Applicants responded on Jul. 5, 2007 with a response and a supplemental IDS stating that:

..... the Office Action is requesting information beyond that which is required under 37 CFR §1.105. As set forth in MPEP §704.11, 35 CFR 1.105 is drafted "to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR §1.105 are not requesting opinions that may be held or would be required to be formulated by applicant." (emphasis added). Identification of specific claims in those applications and/or patents which may present double patenting issues with the instant application claims is clearly opinion which is not required under 37 CFR §1.105.

On Aug. 24, 2007, in response, Examiner mailed a reply informing the Applicants that Applicants had failed to provide a listing of claims relevant to the possible double patenting issue. The applicant was reminded that the period to comply with Rule 105 requirement from the previous Office action of May 3, 2007 remains unchanged.

Applicants responded on Oct. 3, 2007, with a response, stating,

In response to the requirement to identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims, Applicants respectfully submit that any of the claims in any of the applications or patents identified in the May 3, 2007 Office Action or in the July 5, 2007 Reply may present double patenting issues with the instant application claims by virtue of such applications or patents having a common inventor with the present application. Applicants do not make any comments as to whether any of these claims do or do not present a double patenting issue. With the identification of such applications and patents, the Examiner has all of the information necessary to review the claims and make a determination if double patenting exists with respect to any claims. In view of Applicants' identification of such patents and applications, and Applicants' submission of this known and reasonably available factual information, Applicants respectfully submit that this Response is fully responsive to every appropriate request in the Office Action. With respect to the example double patenting rejections not being addressed, Applicants respectfully note that a double patenting rejection has not been raised in any Office Action to date. Upon receipt of an Office Action rejecting any claim based on double patenting, Applicants will address such with an appropriate response. If the Examiner believes other factual information is necessary to the examination, the Examiner is invited to issue a follow up requirement setting forth the specific factual information being required, the form the required information is to take, and how the information is necessary to the examination as set forth in MPEP §704.14(a).

On Oct. 3, 2007, the current petition was filed. In particular, Applicants submits that Examiner's requirement for a listing of claims relevant to the possible double patenting issue is beyond the scope 37 CFR § 1.105. Applicants state that Examiner is requiring more than facts or factual information as intended by 37 CFR § 1.105, but is instead requiring an opinion by requiring an evaluation of the claims of any of the listed and to be listed applications and patents that may be related with respect to statutory or obviousness-type double patenting.

Discussion

In the instant case, Applicants' Jul. 5, 2007 response to Examiner's 37 CFR 1.105 Requirement failed to provide a listing of claims relevant to the possible double patenting issue. Thus, Applicants' response was an incomplete reply and Examiner issued a non-responsive letter. In the petition, petitioner argues that to the extent the Supplemental Response is deemed to be not fully responsive, that this additional requirement in the May 3, 2007 Office Action (requiring Applicants to identify specific claims) is requesting information beyond that which is required under 37 CFR §1.105. Petitioner also argues that requirements under 37 CFR §1.105 are not requesting opinions that may be held or would be required to be formulated by applicant. Identification of specific claims in those applications and/or patents which may present double patenting issues with the instant application claims is clearly opinion that would be required to be formulated, which is not required under 37 CFR 1.105. With the list of related applications and the patents listed in the IDS statements and the additional published applications and patents identified in the Response of Jul 5, 2007, petitioner opines that the Office has available to it all the information that is necessary to review the claims of the various applications and patents and make any double patenting determinations. The Office is fully capable of examining the various claims and making determinations of double patenting. The required information is

not necessary for the Office to proceed with such examination. Since the Office Action is requesting information which is not necessary for examination and which is not factual information, but instead opinion which is not required under 37 C.F.R. §1.105, and to any extent that Applicants' Supplemental Response is not deemed to be fully responsive, Applicants respectfully submit that the Requirement under 35 C.F.R. 1.105 is improper and should be withdrawn.

This line of argument is unconvincing. With respect to Applicants' claim that Examiner's requirement for a listing of claims relevant to the possible double patenting issue is beyond the scope of 37 CFR § 1.105, M.P.E.P. 704.11 states, in part,

The terms "factual" and "facts" are included in 37 CFR § 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR § 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant...

The purpose of 37 CFR § 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information."

From a recent Federal Circuit decision:

Scope of information that may be required from applicant by patent examiner pursuant to 37 C.F.R. §1.105 encompasses information relevant to patent examination either procedurally or substantively, and includes zone of information beyond that defined by 37 C.F.R. §1.56 as material to patentability, and beyond that which is directly useful to support rejection or conclusively decide issue of patentability, since Section 1.105(a)(1) states that PTO may "require the submission ... of such information as may be reasonably necessary to properly examine or treat the matter"[.] *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

Duty of candor embodied in 37 C.F.R. §1.56 does not give patent applicant power to refuse requirement for information under 37 C.F.R. §1.105, since neither regulation states that response to such requirement may be limited, at applicant's discretion, to whatever applicant believes it might be affirmatively required to submit under Section 1.56, since language in Section 1.105(a)(1), which permits PTO to "require the submission ... of such information as may be reasonably necessary to properly examine or treat the matter," expressly states that PTO, not applicant, controls scope of requirement for information, and since scope of information that may be required under Section 1.105 is broader than information that applicant is duty bound to provide under Section 1.56. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

United States Patent and Trademark Office can use requirement for information under 37 C.F.R. §1.105 to compel disclosure of information that patent examiner deems pertinent to patentability, even if applicant disagrees with examiner concerning significance of information to ultimate question of whether application discloses patentable subject matter, since PTO is clearly entitled to use Section 1.105 to seek information that may support rejection, and since examiner is charged with duty of deciding whether patent should issue from application, and so long as examiner's request for information is not arbitrary or capricious, applicant cannot impede examiner's performance of that duty by refusing to comply with information requirement that proceeds from examiner's view of scope of law to be applied to application. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

If an applicant were required to make an admission that the claims of one application or patent read on the claims of another, it would appear that this would be beyond the scope of 37 CFR § 1.105. However, in the present situation, Applicants are not being asked this but to identify claims that *may* present double patenting issues. Applicants would be making comparisons to

identify similarities in the claims. This is not an admission that the claims conflict. Examiner still will determine this. Applicants would be identifying observed facts and then Examiner would render an opinion from these facts. Thus, an opinion from Applicants is not being required.

Nevertheless, it appears that the Court considers forms of opinion relevant and within the authority of the Examiner to require.

...Other requirements for information are also foreseeable under the "reasonably necessary to properly examine or treat the matter" standard. For instance, it might be reasonably necessary for the Office to require an explanation of technical material in a publication, such as one of the inventor's publications, or require the applicant's *comments* on a recent Federal Circuit opinion and how that opinion affects examination. ... The final rule permits that "the examiner or other Office employee may *require the submission* ... of such information as may be reasonably necessary to properly examine or treat the matter." 37 C.F.R. 1.105(a)(1) [emphasis added] *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

Through notice and comment rulemaking the Office made explicit the inherent authority of Office employees to require information from an applicant. The goal is to "encourage" employees to use that power to "perform the best quality examination possible." *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 73 USPQ2d 1409 (Fed. Cir. 2005).

Opinion is clearly permitted to the extent it may define viable information. This is not different from an applicant citing a reference for consideration before the examiner, as this is an opinion as to what is believed material to patentability under 37 CFR § 1.56. The examiner considers that reference and ultimately determines whether that reference is to be applied against the claims. When the examiner requires a submission of information under 37 CFR § 1.105 that may be material to patentability, the examiner is still making the ultimate decision based on the submission whether that material is applicable. The examiner has required this information because it "improve[s] patent quality, and render[s] better decisions" (MPEP 704.11).

Thus, according to M.P.E.P. 704.11 and the Federal Circuit Court, Examiner's requirement for a listing of claims relevant to the possible double patenting issue is within the scope of 37 CFR § 1.105. The listing requirement is further supported by the Court's implications that forms of opinion may be relevant and within the authority of the Examiner to require if it is providing material information.

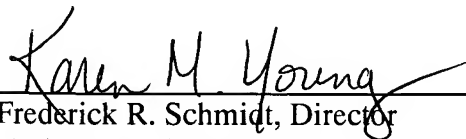
In the instant case, Applicants timely filed a response to Examiner's May 3, 2007 37 CFR § 1.105 Requirement on Jul. 5, 2007. Because Applicant failed to comply with the Rule 1.105 requirement, on Aug. 24, 2007, Examiner sent a letter informing Applicants that the response of Jul. 5, 2007 was not fully responsive. The Applicants were also informed that since the period of reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a). Applicants' second reply of Oct. 3, 2007 with three-month extension of time did not perfect the required response. Therefore, the time period for response will continue to run from the mail date of the previous Office action of May 3, 2007. Because the mail date of the previous Office action is May 3, 2007 and the applicant paid a three-month extension fee, the application became abandoned on Nov. 5, 2007.

Conclusion

Ultimately, the purpose in requiring Applicants to identify claims in the identified and yet to be identified related applications and patents is to improve the quality of examination by the examiner with respect to statutory and obviousness-type double patenting particularly in view of the significant number of applications and patents involved. In view thereof, the examiner's requirement is not seen as unreasonable and is seen as within the scope of 37 CFR § 1.105.

PETITION DISMISSED.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-3468.

for 

Frederick R. Schmidt, Director
Technology Center 3700